

PATENT

Atty Docket No.: 70019413-1

App. Ser. No.: 10/773,910

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks. By virtue of the amendments above, Claims 1 and 7 have been amended and Claim 4 has been canceled without prejudice or disclaimer of the subject matter contained therein. Currently, therefore, Claims 1-3 and 5-7 are pending in the present application, of which, Claims 1 and 7 are independent.

No new matter has been introduced by way of the claim amendments; entry thereof is therefore respectfully requested.

Information Disclosure Statement

The indication that the Information Disclosure Statement filed on February 5, 2004 has been considered is noted with appreciation.

Drawings

The indication that the drawings submitted on February 5, 2004 have been accepted is also noted with appreciation.

Claim Rejection Under 35 U.S.C. § 112, second paragraph

The Official Action sets forth a rejection of Claim 4 as allegedly being indefinite. Claim 4 has been cancelled without prejudice or disclaimer of the subject matter contained therein. Accordingly, the rejection of Claim 4 is considered moot and the Examiner is respectfully requested to withdraw the rejection of Claim 4.

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Claim Rejection Under 35 U.S.C. §102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

The Official Action sets forth a rejection of Claims 1-4 and 7 as allegedly being anticipated by the disclosure contained in U.S. Patent No. 5,743,522 to Rubscha et al. This rejection is respectfully traversed because Rubscha et al. fails to disclose the invention as set forth in Claims 1-4 and 7.

The Official Action asserts that the actuator 32 and the optical switch 39 of Rubscha et al. read on the probe and detector of the claimed invention. As shown, for instance, in Figure 4 of Rubscha et al., the actuator 32 and the optical switch 39 are positioned beneath a tray 12 for supporting sheets. In this regard, the actuator 32 and the optical switch 39 are located on the same side of the sheets when the sheets are positioned on the tray 12.

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In contrast, independent Claims 1 and 7 have been amended to include that the probe and the detector are located on opposite sides of media when the media stack tray has a loaded status. As such, Rubscha et al. fails to disclose each and every element of the invention as claimed in Claims 1 and 7 of the present invention and therefore cannot anticipate these claims. Accordingly, the Examiner is respectfully requested to withdraw the rejection of Claims 1 and 7 and to allow these claims.

Claims 2 and 3 are also allowable over Rubscha et al. at least by virtue of their dependencies upon allowable Claim 1.

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

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Claim 5

The Official Action sets forth a rejection of Claim 5 under 35 U.S.C. § 103(a) as allegedly being unpatentable over the disclosure contained in Rubscha et al. in view of U.S. Patent No. 5,033,731 to Looney. This rejection is respectfully traversed because Rubscha et al. and Looney, considered singly or in combination, fail to disclose the invention as set forth in independent Claim 1 and Claim 5 of the present invention.

As discussed herein above, Rubscha et al. fails to disclose each and every element claimed in Claim 1, upon which Claim 5 depends. In addition, the Official Action does not assert that Looney makes up for the deficiencies in Rubscha et al. with regard to Claim 1. For at least this reason, the proposed combination of Rubscha et al. and Looney fails to disclose the claimed invention as set forth in Claim 5.

The motivation to modify Rubscha et al. based upon the disclosure contained in Looney is also deficient. The Official Action argues that it would have been obvious to modify Rubscha et al. to "position the location of the detector and the dispensing device to be on the same side of the media stack without losing[sic] the described functionality of the Rubscha device." In other words, the Official Action argues that Rubscha et al. should be modified because the functionality of the Rubscha et al. device would not be harmed. The mere fact, however, that a device may be modified is not proper motivation for modifying the device. Instead, there must be some suggestion or motivation to modify the reference or to combine reference teachings to establish a *prima facie* case of obviousness, as set forth in MPEP § 706.02(j). As such, the Official Action has failed to establish a *prima facie* case of obviousness based upon the proposed combination of Rubscha et al. and Looney.

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Accordingly, the Examiner is respectfully requested to withdraw the rejection of Claim 5 and to allow this claim.

Claim 6

The Official Action sets forth a rejection of Claim 6 under 35 U.S.C. § 103(a) as allegedly being unpatentable over the disclosure contained in Rubscha et al. in view of U.S. Patent No. 5,248,137 to Rabjohns. This rejection is respectfully traversed because Rubscha et al. and Rabjohns, considered singly or in combination, fail to disclose the invention as set forth in independent Claim 1 and Claim 6 of the present invention.

As discussed herein above, Rubscha et al. fails to disclose each and every element claimed in Claim 1, upon which Claim 6 depends. In addition, the Official Action does not assert that Rabjohns makes up for the deficiencies in Rubscha et al. with regard to Claim 1. For at least this reason, the proposed combination of Rubscha et al. and Rabjohns fails to disclose the claimed invention as set forth in Claim 6.

The proposed motivation to combine Rubscha et al. and Rabjohns is also improper because the assertion that such a modification would be obvious "in areas where the movement of the dispensing device is not desired and can not be accommodated" does not assert that the proposed modification of Rubscha et al. would be obvious. As such, the Official Action has failed to establish a *prima facie* case of obviousness based upon the proposed combination of Rubscha et al. and Rabjohns.

Accordingly, the Examiner is respectfully requested to withdraw the rejection of Claim 6 and to allow this claim.

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Conclusion


In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: August 22, 2005

By


Timothy B. Kang
Registration No.: 46,423

MANNAVA & KANG, P.C.
8221 Old Courthouse Road
Suite 104
Vienna, VA 22182
(703) 652-3817
(703) 880-5270 (facsimile)